

Amendment and Response
Serial No. 09/920,439

REMARKS

Claims 1-2, 6-7, 9-12, 16-17, and 37-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 2,333,303 to Enos (hereinafter "Enos"); claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Enos; and claims 1-2, 5, 7-12, 15, 17-20, and 37-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,237,758 to Zachman (hereinafter "Zachman") in view of United States Patent Number 2,557,946 to Crooker (hereinafter "Crooker").

Applicants hereby amend independent claims 1 and 11 and dependent claims 7 and 17, and add new dependent claims 39-42. Specifically, independent claims 1 and 11 are amended to recite a discrete continuous mesh layer that is partially embedded in the sole layer and partially continuously exposed along the ground engaging surface. No new matter is entered thereby. Support for the amendments to independent claims 1 and 11 can be found in Applicants' specification at least at paragraphs [0014], [0019], [0022], [0027], [0029], [0033], [0036]-[0037], and [0040], and in Applicants' FIGS. 1C, 2B, 3B, 4A, 5, and 7-8. Dependent claims 7 and 17 are amended to correct certain typographical errors. No new matter is entered thereby. Claims 39-42 are added to recite a mesh layer that extends along a front surface of the sole layer and to recite a mesh layer that extends along a side surface of the sole layer. No new matter is entered thereby. Support for the new claims can be found in Applicants' specification at least at paragraphs [0014]-[0015] and [0021], and in Applicants' FIGS. 1A and 5. Claims 39-40 and 41-42 depend directly from amended independent claims 1 and 11, respectively, and, therefore, incorporate all of the respective limitations thereof. In addition, Applicants hereby amend paragraphs [0005], [0007]-[0009], [0018], [0021], [0027], [0029], [0032], [0034], and

Amendment and Response
Serial No. 09/920,439

[0038]-[0039] to correct certain typographical errors. No new matter is entered thereby.

Claims 1-20 and 37-38 are currently pending and presented for reconsideration. Claims 39-42 are added and presented for consideration. In view of the above amendments and following remarks, reconsideration and withdrawal of all grounds of rejection are respectfully requested.

1. Claims 1-2, 6-7, 9-12, 16-17, and 37-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Enos. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Enos appears to describe a sole that is produced by partially impregnating a fabric, which may be a woven fibrous structure, with a rubber or equivalent composition. Purportedly, the fabric imparts anti-slipping characteristics to the sole, while impregnation with rubber and the like enhances the strength of the fabric and affords protection against moisture. See, generally, lines 28-52 of the first column and lines 8-10 of the second column on the second page of text of Enos.

In order for a claim to be anticipated under 35 U.S.C. § 102(b), each and every limitation of the claim must be found in a single reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also, MPEP § 2131. Moreover, "the prior art cannot anticipate the claim if there is any structural difference." See MPEP § 2114 (emphasis added).

Amendment and Response
Serial No. 09/920,439

Applicants respectfully submit that Enos fails to be a proper anticipatory reference to Applicants' amended independent claims 1 and 11, because Enos does not teach or suggest "*a sole layer . . . and a discrete continuous mesh layer,*" as recited by amended independent claims 1 and 11. Specifically, in Enos, the foundation 10 (*i.e.*, the body portion) includes a first surface 12 and a second surface 14. An unimpregnated portion 15 of the body portion extends inwardly from the second surface 14 towards the first surface 12. See, generally, lines 21-31 of the second column on the first page of text of Enos. In other words, the unimpregnated portion 15 is a portion of the larger foundation 10. As such, even assuming, *arguendo*, that the unimpregnated portion 15 forms a sole layer and that the foundation 10 forms a mesh layer, as argued in the Office action, the unimpregnated portion 15 and the foundation 10 are not discrete elements, as required by Applicants' amended independent claims 1 and 11. Rather, the unimpregnated portion 15 is just a portion of the foundation 10. Because of this structural difference between the claimed invention and the disclosure of Enos, Enos fails to be a proper anticipatory reference to Applicants' amended independent claims 1 and 11.

Accordingly, Applicants respectfully submit that independent claims 1 and 11, as amended, are allowable over Enos. Because claims 2, 6-7, 9-10, 12, 16-17, and 37-38 depend, either directly or indirectly, from either amended independent claim 1 or 11, Applicants respectfully submit that these claims are allowable as well. Reconsideration and withdrawal of the rejection of claims 1-2, 6-7, 9-12, 16-17, and 37-38 under 35 U.S.C. § 102(b) as being anticipated by Enos are, therefore, respectfully requested.

2. Claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Enos. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Amendment and Response
Serial No. 09/920,439

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 706.02(j).

Applicants respectfully submit that a prima facie case of obviousness has not been established with respect to claims 3-4 and 13-14, in view of the amendments to independent claims 1 and 11, respectively.

As discussed hereinabove in section 1, Enos does not teach or suggest "*a sole layer . . . and a discrete continuous mesh layer*," as recited by Applicants' amended independent claims 1 and 11 and incorporated into dependent claims 3-4 and 13-14, respectively. Therefore, in view of the allowability of independent claims 1 and 11, Applicants respectfully submit that claims 3-4 and 13-14 are allowable over Enos, as well. Reconsideration and withdrawal of the rejection of claims 3-4 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Enos is respectfully requested.

3. Claims 1-2, 5, 7-12, 15, 17-20, and 37-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of Crooker. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Amendment and Response
Serial No. 09/920,439

Briefly, Zachman appears to describe a safety shoe sole construction 10. The safety shoe sole construction 10 includes a flexible shoe sole 12 and a shoe upper 11 that is mounted on the shoe sole 12 and that extends upwardly therefrom. At least one metallic fabric mesh web 15 is fully embedded between the top and bottom surfaces and the outer periphery 14 of the shoe sole 12. The metallic fabric mesh web 15 purportedly prevents inadvertent and accidental piercing of the shoe sole 12 by various foreign objects, such as nails, spikes, and the like. See, generally, column 3, lines 28-40, of Zachman.

Crooker appears to describe a non-skid rubber sole construction. A sole 10 includes, on its outer surface, transverse ribs 12 spaced apart by transverse grooves 13. The ribs 12 have a rounded outer surface contour 14. Extending longitudinally within each of the transverse ribs 12 is a helical coil 15. The coil 15 is positioned within the rib 12 so that a side portion of the coil 15 is substantially flush with the outer rounded surface 14 of the rib 12. Purportedly, when one of the soles 10 is donned, overtime the outer portions 14 of the ribs 12 wear. This wear exposes the outer portions of the coils 15 and thereby provides a plurality of road gripping elements exposed along the wearing surfaces of the ribs 12. See, generally, column 2, lines 18-32 and 44-50, of Crooker.

Applicants respectfully submit that neither Zachman nor Crooker, alone or in proper combination, teach or suggest all the limitations of independent claims 1 and 11, as amended. Specifically, Applicants' amended independent claims 1 and 11 each recite "*a discrete continuous mesh layer . . . partially continuously exposed along the ground engaging surface.*" In distinct contrast, neither Zachman nor Crooker, alone or in proper combination, teach or suggest such a structure.

Amendment and Response
Serial No. 09/920,439

With respect to Zachman, the mesh web 15 is fully embedded within the shoe sole 12 between its top surface and its bottom surface, and within its outer periphery 14. See, for example, column 3, lines 34-37, and FIGS. 1 and 2, of Zachman. The mesh web 15 of Zachman is not exposed at all and is not, therefore, "partially continuously exposed along the ground engaging surface" of the shoe sole 12, as required by Applicants' amended independent claims 1 and 11.

With respect to Crooker, Applicants respectfully submit that the disclosure of Crooker fails to cure the deficiencies of Zachman with respect to amended independent claims 1 and 11. Specifically, as discussed hereinabove, it is only after the sole 10 is worn that the outer portions 14 of the ribs 12 become subject to wear, eventually exposing solely the outer portions of the coils 15. See, generally, column 2, lines 44-48, of Crooker. The coils 15 of Crooker are not, therefore, "partially continuously exposed along the ground engaging surface" of the sole 10, as required by Applicants' amended independent claims 1 and 11.

Further, the coils 15 of Crooker do not form a "continuous mesh layer." Specifically, and in distinct contrast to Applicants' claimed invention, Crooker merely describes a series of transversely disposed discrete helical coils 15. Moreover, even assuming, arguendo, that the helical coils 15 may be considered a mesh layer, the coils 15, as stated in Crooker, are a series of discrete, transversely disposed coils. Therefore, even under such an assumption, the helical coils 15 do not form a "continuous mesh layer." See, for example, column 2, lines 24-43, of Crooker.

For at least these reasons, Applicants respectfully submit that independent claims 1 and 11, as amended, are allowable over Zachman in view of Crooker. Because claims 2, 5, 7-10, 12, 15, 17-20, and 37-38 depend either directly or indirectly, from either amended independent claim

Amendment and Response
Serial No. 09/920,439

1 or 11, Applicants respectfully submit that these claims are allowable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-2, 5, 7-12, 15, 17-20, and 37-38 under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of Crooker.

4. Applicants respectfully submit that new dependent claims 39-40 and 41-42, which depend directly from amended independent claims 1 and 11, respectively, are patentable as a matter of law, because claims 1 and 11 are patentable at least for the reasons stated in sections 1 and 3. Accordingly, Applicants respectfully request allowance of claims 39-42 in due course.

5. Applicants submitted a certified copy of the priority document, German Patent Application No. 10037728.9, at the time of filing the present application, and requested confirmation of receipt of the certified priority document in the Amendment and Response filed April 30, 2003. Applicants have not, however, received acknowledgement of the receipt of the certified priority document. Please confirm receipt of the certified priority document in the next communication.

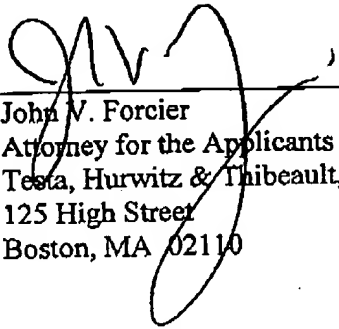
Amendment and Response
Serial No. 09/920,439

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-20 and 37-42 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

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